

## **REMARKS**

### **A. Rule 173(c) Statement of Status of Claims and Support for Claim Changes**

The status of the claims following entry of the amendment above is: claims 1-9, 11, 12, 14, 50-53, 55, 56, 59-64, 66-78 are pending, and claims 10, 13, 15-49, 54, 57, 58, and 65 are canceled.

Claims 19, 20, 22, and 54 have been canceled by this paper.

### **B. The Objection to Claim 22 and the Indefiniteness Rejection of Claims 19, 20, 22, and 54 Is Moot**

The Office rejects these claims as indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. The Office also objected to claim 22 not reciting the phrase “at least one.” In order to expedite prosecution, and not in acquiescence to the Office’s position, the rejected claims have been canceled, rendering the rejection and objection moot.

### **C. Claims 5-9, 11, 12, 14, 50-53, 55, 56, 59-64 and 66-78 Are Patentable over Walker in view of Brock**

These claims stand rejected as obvious over Walker (US 4,590,714) in view of Brock (US 4,038,447). Applicants respectfully traverse.

#### **1. Independent Claims 5, 50, 55, 56, 60 and 63**

As inventor Michael A. Morgan notes in his attached Rule 132 declaration, independent claims 5, 50, and 55 all specify “at least two sealed panels.” Claim 56 specifies that insulation material is “sealed inside each panel.” Claims 60 and 63 each specifies that “each panel includes insulation material sealed inside, but not completely filling, a void in the panel.” August 24, 2009 Rule 132 Declaration of Michael A. Morgan at § 3.

Neither Walker nor Brock teach panels that are sealed watertight. This is undisputed. *See* Action at p. 4, where the Office admits, “Walker fails to provide that the seams 41 and 42 are sealed[,]” and at p. 9, where the Office notes the passages 226 located between the “heat seals or fused portions 219” of Walker (as clearly shown in FIG. 8). The Office contends that Applicants claims are not limited to watertight panels, Action at p. 9, but the Office is incorrect.

As Mr. Morgan explains, someone of ordinary skill in the art at the time the original application was filed (in 1993) would have understood the claim language as specify watertight-sealed panels. He identifies the language from the specification that supports his view in paragraph 4 of his Rule 132 declaration:

4. The original patent application, which was filed October 22, 1993, explains that “[t]he primary advantage of the invention is that it is removeable, thus allowing the pond to be dredged and re-used.” 3<sup>rd</sup> paragraph of first page (attached as Appendix A); same at column 1, lines 18-20 of the ‘549 patent (attached as Appendix B). The original patent application states that “[e]ach casing 1 is filled with a layer of insulation 3 and then sealed at either end and along either side by a fusion weld 4.” App. A at last full paragraph on page 1; App. B at column 1, lines 37-39. Then, the first full sentence on page 2 of the original patent application states, “Each casing 1 is provided with a plurality of grommets 5 at either end and along either side, positioned outside of the welded area so as not to break the seal.” App. A; App. B at column 2, lines 1-4.

*Id.* at § 4. Mr. Morgan states that, at the time the original patent application was filed, “someone having even minimal experience in the field of wastewater covers would understand from reading the original patent application—and in particular the sentences cited above—that the sealed panels stated in the claims refer to panels that have been sealed to be watertight.” *Id.* at §

5. As Mr. Morgan explains, it would have otherwise been difficult to meet the “primary advantage” of the invention:

Such a person would have readily understood that it would be very difficult to meet the “primary advantage” of our invention (removing and reusing our linked panels in order to dredge a wastewater pond) if the panels were not sealed

watertight because wastewater would get into the panels as they were being moved around over the wastewater pond, making them heavier and more difficult to move.

*Id.* at § 5.

Furthermore, the sentence in the original application that explains that the grommets are positioned outside the welded are “so as not break the seal” **would not make any sense** unless the referenced seal was watertight (otherwise there is nothing to break):

The sentence that explains that the grommets described in the application are positioned outside the welded area so as not to break the seal makes this even more clear: no one in this industry would be concerned about breaking a “seal” that was intermittent or otherwise not watertight. So, the only way that sentence makes sense is in reference to a seal that is watertight. Therefore, that is how anyone in this field would have read and understood the claimed seals: as watertight.

*Id.* at § 5 (emphasis in original).

Mr. Morgan notes that claims 50, 56, 60 and 63 all specify insulation material inside each sealed panel. *Id.* at § 6. The advantage specified right after removability in the original patent application is insulative (“[a]nother advantage is that the insulation results in heat being retained in the pond”), and that advantage would have been impaired or eliminated if the seals were not watertight because the wastewater would get into the panels and fill the voids in the insulation, rendering them no longer effective as an insulator. *Id.* at § 6. As Mr. Morgan explains, “[a]nyone in this industry would have understood and appreciated this fact at the time the original patent application was filed.” *Id.*

Of note, the Office’s statement that “Walker recites ‘sealed’ at column 3, line 19” is not relevant. Mr. Morgan explains why:

7. Finally, the Patent Office states: “Also note that Walker [U.S. Patent No. 4,590,714] recites ‘sealed’ at column 3, line 19.” Page 9 of the Office Action. However, this “sealed” language in Walker does not pertain to Walker’s tarpaulin

itself being sealed. Instead, it pertains to the membranes of the tarpaulin being sealed:

A first membrane of extremely tough and weather resistant material such as 5 X 10 woven and sealed highly oriented high density polyethylene material of notorious type is coated with an ultraviolet resistant material of some dark color.

This statement is irrelevant to the seals recited in our claims.

*Id.* at § 7.

For these reasons, the “at least two sealed panels” in claims 5, 50 and 55 are at least two panels sealed watertight, the insulation material “sealed inside each panel” in claim 56 is sealed watertight inside each panel, and the insulation material “sealed inside” a void in each panel in claims 60 and 63 is sealed watertight inside a void in each panel. Walker nor Brock teaches or suggests these limitations, and the rejection of claims 5, 50, 55, 56, 60 and 63 and their rejected dependents is overcome.

## **2. Independent Claim 71**

This claim recites:

71. A method of covering wastewater, comprising:  
disposing at least two panels over wastewater that includes sewage and/or industrial waste, where the at least two panels are linked to each other and each contains, but is not completely filled with, insulation material.

The Office’s rationale for why this claim is purported obvious over Walker in combination with Brock and statements from the background of the original patent application is not sufficient to establish a *prima facie* case of obviousness. The Office contends:

It would have been obvious at the time of the invention to one having ordinary skill in the art that the geomembrane covering system taught by Walker as modified by Brock could have been used to cover wastewater as Walker teaches that his system is design to cover and protect an underlying structure or material and the use of geomembrane covering systems over wastewater was known at the time of the invention. There would have been no unexpected or unpredictable result achieved from using the known covering system of Walker as modified by Brock in an environment where it was known to be desirable to provide a cover. One of ordinary skill in the art would have recognized that the covering system of Walker could have been placed in direct contact over wastewater.

Action at p. 5. Mr. Morgan explains why no one who works in his industry would do or think to do what the Office proposes:

The problem with this reasoning is that if someone were to place the tarpaulin of Walker—with stitched seams or with intermittently-welded seams (as disclosed in Brock)—over wastewater, the tarpaulin would take on wastewater and become heavy and difficult to move, and the wastewater would fill the voids in the insulation, rendering the tarpaulin no longer effective as an insulator. Therefore, someone who works in this industry would not do (or think to do) what the Patent Office has proposed.

Morgan Dec. at §§ 8-9.

For these reasons, the rejection of independent claim 71 and its rejected dependents is overcome.

**D. Claims 56 and 59-62 Are Patentable over Brock in view of Walker**

These claims stand rejected as obvious over Brock in view of Walker. Applicants respectfully traverse. For the reasons provided above, the insulation material “sealed inside each panel” in claim 56 is sealed watertight inside each panel, and the insulation material “sealed inside” a void in each panel in claim 60 is sealed watertight inside a void in each panel. Walker

nor Brock teaches or suggests these limitations, and the rejection of claims 56 and 59-62 is overcome.

**E. The Section 251 Rejection Is Overcome**

Concurrently filed with this response are supplemental reissue declarations from both inventors that comply with Rule 175. The Section 251 rejection is therefore overcome.

**F. Conclusion**

Applicants respectfully submit that claims 1-9, 11, 12, 14, 50-53, 55, 56, 59-64, 66-78 are in condition for allowance. Should the Examiner have any questions, comments, or suggestions relating to this application, he is invited to contact the undersigned attorney at (512) 536-3031 to expedite the resolution of any remaining issues.

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Respectfully submitted,

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